

## **REMARKS:**

Claims 1-13 and 27-33 are currently pending in the application.

Claims 14-26 have been previously canceled without *prejudice*.

Claims 1-13 and 27-33 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,758,327 to Gardner *et al.* ("*Gardner*").

## **FINAL REJECTION, PREMATURE:**

The Applicants respectfully submit that the finality of the Office Action mailed 21 June 2006 is premature. In response to a Final Office Action dated 22 December 2005, the Applicants submitted a Response to the Final Office Action on 21 March 2006, including a Request for Continuation to allow for the entry of the Response. In the Response filed on 21 March 2006, the Applicants amended independent Claims 1 and 27-29 and added new Claims 30-33 in order to more particularly point out and distinctly claim the Applicants invention. The Applicants respectfully submit that new Claims 30-33 raised new issues that required further consideration and/or search by the Examiner. However, although the Examiner acknowledges the addition of new Claims 30-33 in the Preliminary Remarks section of the Office Action mailed 21 June 2006. The Office Action fails to object or reject the new issues raised in new Claims 30-33, in regards to the cited prior art, or any prior art. Therefore, the Applicants respectfully request reconsideration of the finality of the rejection of the Office Action mailed 21 June 2006 and that the finality be withdrawn. (see MPEP § 706.07(c), (d), and (e)).

## **RESPONSE TO EXAMINER'S ARGUMENT:**

The Examiner asserts that if "the references [*Gardner*] applied to the [35 U.S.C. § 102] rejection fail to use the same names for certain elements as the names used by applicant, the argument is *irrelevant*". (21 June 2006 Final Office Action, Page 8). (Emphasis Added). The ***Applicants respectfully disagree and further respectfully***

**request the Examiner to cite a specific rule in 37 C.F.R. or in the MPEP** that specifically states that the Applicants arguments are “**irrelevant**”, if the references applied to a 35 U.S.C. § 102 rejection fail to use the same names for certain elements as the names used by the Applicant.

In support of the Examiner's above allegations, the Examiner cites, *In re Bond*, 15 USPQ2d 1566 (Fed. Circ. 1990), as holding that a reference “need not be in the identical words as used in the claims in order to be anticipatory.” (21 June 2006 Final Office Action, Page 8). The Applicants respectfully disagree and further respectfully submit that *In re Bond* does not hold the alleged holding as asserted by the Examiner and even if it does, which it does not, the facts in *In re Bond* are clearly distinguishable.

The Applicants respectfully direct the Examiner's attention to the pertinent parts of *In re Bond* regarding the 35 U.S.C. § 102 anticipation rejection:

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). These elements must be arranged as in the claim under review, *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In *In re Bond*, the court reviewed the United States Patent and Trademark Office Board of Patent Appeals and Interferences (Board) decision, affirming the Examiner's final rejection of Appellants claims. In *In re Bond*, the patent application was directed to the remote turn-on feature of a telephone answering machine. In particular, Claim 1 provided for *inter alia*, a combination of control means, first circuit means, second circuit means, and delay means. The Examiner rejected Claim 1 under 35 U.S.C. § 102 over U.S. Patent No. 3,723,656 to Curtis, et al. (“*Curtis*”). However, Claim 1 was a means-plus-function claim of which the court articulated:

While a “means-plus-function” limitation may appear to include all means capable of achieving the desired function, the statute requires that it be “construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” 35 U.S.C. § 112 paragraph 6.

The court reasoned that the “Board made no finding that the delay means of Claim 1 and that embodied in the *Curtis* device [were] structurally equivalent.” The court held that the Boards “decision as to the anticipation of Claim 1 [was] deficient and must be vacated.” In addition, the court also reversed the Board’s holding regarding the obviousness rejection.

Like the *In re Bond* case, where the court stated that in order for “a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference”. The Applicants respectfully submit that the Examiner has mischaracterized the *In re Bond* holding including the Examiner’s assertion that a reference “need not be in the identical words as used in the claims in order to be anticipatory”. (21 June 2006 Final Office Action, Page 8). Furthermore, unlike the *In re Bond* case, where the 35 U.S.C. § 102 rejection was based on the means-plus-function language of Claim 1, the Examiner, in the subject Application has not objected or rejected any claim under 35 U.S.C. § 112 paragraph 6.

In addition, to the *In re Bond* case being distinguishable from the subject Application, the Applicants respectfully caution the Examiner, in the use of the *In re Bond* case, as there is possible negative treatment associated with the *In re Bond* case including various subsequent holdings that have criticized the *In re Bond* opinion.

The Applicants respectfully submit that the Applicants do not understand the Examiner’s “**irrelevant**” argument or the Examiner’s use of the *In re Bond* case with respect to the subject Application. The Applicants respectfully request further explanation from the Examiner. The Examiner may call the undersigned, Steven J. Laureanti, at (817) 447-9955 if the Examiner believes that it would be easier to discuss the Examiner’s “**irrelevant**” argument or the Examiner’s use of the *In re Bond* case over the telephone.

## DRAWINGS:

The Applicants thank the Examiner for accepting the formal drawings received on 19 September 2005.

## REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1-13 and 27-33 stand rejected under 35 U.S.C. § 102(b) over *Gardner*.

The Applicants respectfully submit that *Gardner* fails to disclose each and every limitation recited by Claims 1-13 and 27-33. The Applicants further respectfully submit that Claims 1-13 and 27-33 patentably distinguish over *Gardner*. Thus, the Applicants respectfully traverse the Examiner's rejection of Claims 1-13 and 27-33 under 35 U.S.C. § 102(b) over *Gardner*.

### ***Gardner Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims***

For example, with respect to independent Claim 1, this claim recites:

***A fulfillment system associated with a distributed supply chain***, comprising:

***a database operable to store:***

at least one ***customer-specified rule identifying a sourcing constraint*** associated with a customer; and

at least one ***contract value*** associated with a current status of a contract involving the customer; and

***one or more processors collectively operable to:***

***receive an available-to-promise (ATP) request*** comprising a plurality of request line-items each corresponding to a desired product;

***generate one or more component ATP requests*** using at least one rule in the database and based on the request line-items;

***communicate the component ATP requests to at least one supplier*** associated with the desired product, the supplier determined ***according to at least one customer-specified rule*** identifying the sourcing constraint;

***receive a plurality of component quotations from at least one supplier***, each component quotation corresponding to a component ATP request and ***comprising product availability information for one or more corresponding desired products***; and

**generate a quotation** for communication **using** the product availability information and the contract value in the database. (Emphasis Added).

Independent Claims 27-29 recite similar limitations. *Gardner* fails to disclose each and every limitation of independent Claims 1 and 27-29.

The Applicants respectfully submit that *Gardner* has nothing to do with independent Claim 1 limitations regarding a “**fulfillment system associated with a distributed supply chain**” and in particular *Gardner* has nothing to do with independent Claim 1 limitations regarding a “**database operable to store at least one customer-specified rule identifying a sourcing constraint** associated with a customer and at least one **contract value** associated with a current status of a contract involving the customer”. In particular, the Examiner states that “the system of *Gardner* **indeed includes** using at least one customer-specified rule identifying a sourcing constraint in determining which supplier to use”. (21 June 2006 Final Office Action, Page 7). (Emphasis Added). However, the Examiner fails to cite any specific portion of *Gardner*, including the column and line number, that allegedly “**indeed includes**” the limitations recited in independent Claim 1. In addition, the Examiner's conclusory statement that “the system of *Gardner* **indeed includes** using at least one customer-specified rule identifying a sourcing constraint in determining which supplier to use”, is unaccompanied by any evidence or reasoning and is entirely inadequate to support the present rejection. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Gardner* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Gardner*.

The Applicants further respectfully submit that *Gardner* has nothing to do with independent Claim 1 limitations regarding “**one or more processors**” collectively operable to “**receive an available-to-promise (ATP) request** comprising a plurality of request line-items each corresponding to a desired product and **generate one or more component ATP requests** using at least one rule in the database and based on the

request line-items". In fact, the Examiner again fails to cite any specific portion of *Gardner*, including the column and line number, or even assert any argument that *Gardner* anticipates "**one or more processors**" collectively operable to "**receive an available-to-promise (ATP) request** comprising a plurality of request line-items each corresponding to a desired product and **generate one or more component ATP requests** using at least one rule in the database and based on the request line-items", as recited in independent Claim 1. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Gardner* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Gardner*.

The Applicants still further respectfully submit that *Gardner* has nothing to do with independent Claim 1 limitations regarding "**one or more processors**" collectively operable to "**receive a plurality of component quotations from at least one supplier**, each component quotation corresponding to a component ATP request and **comprising product availability information for one or more corresponding desired products**". In particular, the Examiner states that "the system of *Gardner* **indeed includes** receiving quotes that comprise availability information". (21 June 2006 Final Office Action, Page 7). (Emphasis Added). However, the Examiner again fails to cite any specific portion of *Gardner*, including the column and line number, that allegedly "**indeed includes**" the limitations recited in independent Claim 1. In addition, the Examiner's conclusory statement that "the system of *Gardner* **indeed includes** receiving quotes that comprise availability information", is unaccompanied by any evidence or reasoning and is entirely inadequate to support the present rejection. In fact, the Applicants respectfully submit that the Examiner has mischaracterized the Applicants invention and respectfully direct the Examiner's attention to independent claim 1 limitations that provide for "**receiv[ing] a plurality of component quotations from at least one supplier**, each component quotation corresponding to a component ATP request and **comprising product availability information for one or more corresponding desired products**". Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Gardner* and independent Claim 1 cannot be made. The Applicants

further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Gardner*.

The Applicants yet further respectfully submit that *Gardner* has nothing to do with independent Claim 1 limitations regarding “**one or more processors**” collectively operable to “**generate a quotation** for communication **using** the product availability information and the contract value in the database.” In particular, the Examiner states that “the system of *Gardner* **indeed includes** generating a quotation that includes the contract value”. (21 June 2006 Final Office Action, Page 8). (Emphasis Added). However, the Examiner again fails to cite any specific portion of *Gardner*, including the column and line number, that allegedly “**indeed includes**” the limitations recited in independent Claim 1. In addition, the Examiner's conclusory statement that “the system of *Gardner* **indeed includes** generating a quotation that includes the contract value”, is unaccompanied by any evidence or reasoning and is entirely inadequate to support the present rejection. In fact, the Applicants respectfully submit that the Examiner has mischaracterized the Applicants invention and respectfully direct the Examiner's attention to independent claim 1 limitations that provide for “**generat[ing] a quotation** for communication **using** the product availability information and the contract value in the database”. The Applicants respectfully submit that the “**generat[ing] a quotation** for communication” recited in independent claim 1 is generated using the “product availability information and the contract value in the database”. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Gardner* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Gardner*.

#### **The Office Action has Failed to Properly Establish a *Prima Facie* case of Anticipation over *Gardner***

The Applicants respectfully submit that the allegation in the present Office Action that *Gardner* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Gardner* is

considered to anticipate all of the limitations in Claims 1-13 and 27-33. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added).

With respect to the subject application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of the Applicants claimed invention is identically shown in *Gardner*. For example, the Examiner asserts that “the system of *Gardner* ***indeed includes*** using at least one customer-specified rule identifying a sourcing constraint in determining which supplier to use”. (21 June 2006 Final Office Action, Page 7). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. In another example, the Examiner asserts that “the system of *Gardner* ***indeed includes*** receiving quotes that comprise availability information”. (21 June 2006 Final Office Action, Page 7). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. In still another example, the Examiner asserts that “the system of *Gardner* ***indeed includes*** generating a quotation that includes the contract value”. (21 June 2006 Final Office Action, Page 8). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. In addition, the Applicants respectfully submit that the Examiner has not set forth the relevant teachings of *Gardner* including any references to the relevant column and line numbers of *Gardner* or asserted any argument or remarks regarding how each and every element of the Applicants claimed invention is identically shown in *Gardner*.

The Applicants respectfully point out that “it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.” Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully submit that ***the Office Action has failed to establish a prima facie case of anticipation in Claims 1-13 and 27-33 under 35 U.S.C. § 102 with respect to Gardner because Gardner fails to identically disclose each and***

***every element of the Applicants claimed invention, arranged as they are in Applicants claims.***

### **The Applicants Claims are Patentable over *Gardner***

With respect to independent Claims 27-29 these claims include limitations similar to those discussed above in connection with independent Claim 1. Thus, independent Claims 27-29 are considered patentably distinguishable over *Gardner* for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent Claims 2-13 and 31-33: Claims 2-13 depend from independent Claim 1; Claim 31 depends from independent Claim 27; Claim 32 depends from independent Claim 28; and dependent Claim 33 depends from independent Claim 33. Thus, dependent Claims 2-13 and 31-33 are considered patentably distinguishable over *Gardner* and are also considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicants respectfully submit that Claims 1-13 and 27-33 are not anticipated by *Gardner*. The Applicants further respectfully submit that Claims 1-13 and 27-33 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1-13 and 27-33 under 35 U.S.C. § 102(b) be reconsidered and that Claims 1-13 and 27-33 be allowed.

### **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. **Prior Knowledge:** The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or

prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimenta-

tion rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

**CONCLUSION:**

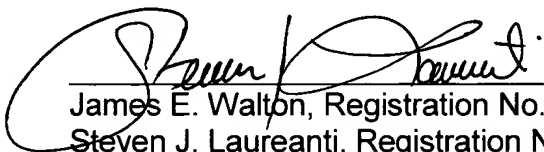
In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

8/10/06  
Date

  
James E. Walton, Registration No. 47,245  
Steven J. Laureanti, Registration No. 50,274  
Daren C. Davis, Registration No. 38,425  
Michael Alford, Registration No. 48,707  
Law Offices of James E. Walton, P.L.L.C.  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955 (voice)  
(817) 447-9954 (facsimile)  
steven@waltonpllc.com (e-mail)

**CUSTOMER NO. 53184**

**ATTORNEYS AND AGENTS FOR APPLICANTS**